

REMARKS

Claims 1-26 are pending in the above-referenced patent application. Applicants respectfully request further consideration of these claims, in view of the amendments set forth above and the following remarks.

DRAWINGS

Formal drawings in compliance with 37 CFR 1.121(d) are submitted herewith. Each of the sheets is marked as "Replacement Sheet" pursuant to 37 CFR 1.121(d).

Amended Claims/New Claims/Canceled Claims

Claim 12 has been amended. No new matter has been added.

Applicants expressly reserve the right to refile any amended or canceled claim, without prejudice, in a continuing application. Applicants' amendment and/or cancellation of any such claims should not, in any way, be considered as an admission with respect to any outstanding rejections applying to such claims.

Claim Rejections under 35 U.S.C. 102

The Examiner has rejected claims 1-10 and 12-26 under 35 U.S.C. 102(e) as being anticipated by Scorro (U.S. 2004/0010180). (See pages 2-5 of the Office action). The Examiner asserts that Scorro discloses a cardiac apparatus with a covering which includes a first portion and a second portion and the apparatus also includes electroactive polymer actuators with a first end and second end. The Examiner further goes on to assert:

Scorro further discloses that as the actuators 102 and 104 are shortened, the volume of the covering 20 is compressed. It is inherent that during this compression, the second portion of the covering 20 moves towards the first portion of the covering 20 via the second end of the electroactive polymer extending away from the first end of the electoractive polymer....

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §

2131.01. Applicants respectfully assert that the Scorvo document does not disclose either expressly or inherently all the limitations of the rejected claims 1-10 and 12-26.

The independent claims 1 and 12 contain the limitation that “upon actuation of said electroactive polymer actuator, said second end of said electroactive polymer actuator extends away from said first end of said electroactive polymer actuator to move said second portion of said covering towards said first portion of said covering.” Thus, per the claims, when the actuators move away from each other the first and second portion of the covering move towards each other. Also, independent claim 19 contains the limitation that the “electroactive polymer actuator” is “configured to expand upon actuation to compress said heart.” The Scorvo document does not describe these limitations either explicitly or inherently.

In paragraph 0054, page 4, the Scorvo document provides as follows:

As the transducers 102 and 104 are shortened or lengthened, the volume 26 of the jacket 20 is reduced or expanded, respectively, and the heart is compressed to aid the muscle in ejecting blood or decompressed to permit the ventricle to refill.

Thus, the Scorvo document teaches that when the actuators lengthen the cardiac apparatus expands, whereas the claims of the present invention are directed to an apparatus in which when the actuators move away from each other, the portions of the coverings come towards each other. Thus, as provided in the specification, “The size adjustment mechanism includes an electroactive polymer actuator configured to expand upon actuation to compress the heart.” See paragraph 0009, page 1, of the published patent application. Hence, Applicants assert that the independent claims 1, 12, and 19 contain at least one limitation that is not disclosed in the Scorvo document.

Further, claims 2-10, 13-18, and 20-26 are dependent claims and include the limitations discussed in the paragraphs above which are not disclosed in the Scorvo reference. Overall, Applicants believe that the rejection under 35 USC 102(e) is improper as all limitations of the claims are not present in the Scorvo document, and respectfully request its withdrawal.

Claim Rejection under 35 U.S.C. 103

The Examiner has rejected claim 11 under 35 U.S.C. 103(a) as unpatentable over Scorvo in view of Couvillon, JR. (U.S. 2004/0167375). (See pages 5-6 of the Office action).

The MPEP provides in § 2142 as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully assert that Scorvo in combination with Couvillon does not teach all the limitations of claim 11. Claim 11 is dependent on claim 9 which is dependent on claim 1 and includes the following limitation, "upon actuation of said electroactive polymer actuator, said second end of said electroactive polymer actuator extends away from said first end of said electroactive polymer actuator to move said second portion of said covering towards said first portion of said covering." As mentioned above, this limitation is not described either explicitly or inherently in the Scorvo reference; and is also not present in the Couvillon reference. Hence, Applicants respectfully assert that the Examiner has not made a *prima facie* case of obviousness and request and withdrawal of the rejection.

CONCLUSION

In view of the foregoing claim amendments and remarks, Applicants respectfully submit that the application is now in condition for allowance. Accordingly, favorable reconsideration and early allowance are requested.

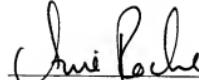
The Examiner is hereby authorized to charge the fees required in connection with this Amendment A to Deposit Account No. 23-2415, in accordance with the Transmittal submitted

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herewith. The Examiner is also authorized to debit any other fees required in connection with this application, or to credit any overpayment of fees in connection with this application to Deposit Account No. 23-2415.

Respectfully submitted,

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